

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

In re application of:)
 Liu et al.)
Serial No.: 10/696,304) Art Unit
) 3663
Filed: October 27, 2003)
Conf. No.: 5109)
For: INTEGRATION OF A GAIN EQUALIZATION
)
)
Examiner: Eric L. Bolda)
Customer No.: 022913)

MAIL STOP: AMENDMENT
Commissioner for Patents
P.O. Box 1450
Alexandria, VA 22313-1450

RESPONSE TO ELECTION OF SPECIES REQUIREMENT

Dear Sir:

In the Office Action mailed July 25, 2006 (the "Office Action"), the Examiner set forth what the Examiner has characterized as an Election of Species Requirement. In particular, the Examiner stated that

"This application contains claims directed to the following patentably distinct species:
Applicant is required under 35 U.S.C. 121 to elect a single disclosed species for prosecution
on the merits to which the claims shall be restricted if no generic claim is finally held to be
allowable (Currently, no claims are generic):

- A. Elect the sequence of gain portions and gain equalization filters.

Note: In regard to the single species election A, applicant is required not to write the election in open-ended (e.g. comprising). An open-ended election will be considered non-responsive. The species are independent or distinct because each arrangement of gain and gain equalization filter portions are mutually exclusive from all others.”

While the Examiner has indicated in the Office Action that the failure of Applicant to make an election will be considered non-responsive, Applicant respectfully notes that the Examiner has failed to identify a group of species from among which the Applicant could elect. In fact, the Examiner has characterized the restriction as constituting a “single species election A” (emphasis added). By definition however, there must be at least two species in order for a restriction, as between/among the species, to be made. Thus, it appears to Applicant that the restriction is improper.

Moreover, Applicant submits that what the Examiner has styled as “Species A” is tantamount to a requirement that Applicant identify, and then select from, various species. That is, Applicant cannot elect a “sequence of gain portions and gain equalization filters” without first having determined what the various sequences, i.e., species, may be. Applicant respectfully submits however, that it is incumbent on the Examiner, and not the Applicant, to identify what the Examiner believes to constitute patentably distinct species.

Inasmuch as the Examiner has failed to identify what the Examiner believes to constitute the patentably distinct species, Applicant is unable to make an election.

If the Examiner believes that restriction is proper in this case, Applicant respectfully requests that the Examiner clearly identify what the Examiner believes to be the species from among which Applicant must elect. See MPEP §§ 806.04, 809.02; and, 37 CFR § 1.146.

Applicant notes that nothing herein should be construed as, an assessment or judgment by the Applicant as to the merits, if any, of: the characterization of the claims and species advanced by the Examiner in the election of species requirement set forth in the Office Action; or, any other assertions, allegations, statements or characterizations made by the Examiner in that election of species requirement.

An action on the merits of claims 1, 4, 5, 10-12, 15 and 38-46 and a Notice of Allowance thereof are respectfully requested. In the event that the Examiner wishes to discuss any of the matters contemplated hereby, the Examiner is invited to initiate a telephone conversation with the undersigned.

DATED this 24th day of August 2006.

Respectfully submitted,



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